REMARKS

Claims 1-25 and 28-40 stand rejected and are presently pending. Applicant respectfully submits that all of the presently pending claims are allowable. Reconsideration of the Application is respectfully requested.

I.   **Rejection of claims 1, 3-5, 8-10, 13, 16, 17, 24, 25, 28, 37, and 40 over Jarvis in view of Novak (35 U.S.C. § 103(a))**

Claims 1, 3-5, 8-10, 13, 16, 17, 20, 24, 25, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jarvis (5,249,801) in view of Novak (5,239,165). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Independent claim 1 recites:

> A gaming slip comprising:
> a substrate; and
> gaming information coupled to the substrate, the gaming information
> including *a random request region corresponding to a single game, wherein*
> *the random request region corresponding to the single game enables a*
> *plurality of computer-generated picks to be requested for the single game.*

(emphasis added). As indicated in the Office Action, Jarvis fails to disclose that a "plurality of quick picks may be selected for a single game." To correct the defects of Jarvis, the Office Action proposes a combination of Jarvis with Novak. Novak's Figure 4 purports to describe a computer generated "pick slip" which includes two quick picks.

The fact that references can be combined or modified does not render the resultant

combination or modification obvious unless the prior art also suggests the desirability of the combination or modification. *See* MPEP 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)). Neither Jarvis nor Novak can be fairly said to suggest the desirability of the Office Action's proposed modification of Jarvis. Applicant respectfully submits that the proposed combination of Novak and Jarvis is a pure hindsight reconstruction, using Applicant's claim 1 as a map. Nothing in either Novak or Jarvis suggests that Novak's multiple quick picks, *which are selected by pushing buttons on a machine,* should be grafted onto Jarvis's manually completed slip to "increase the chances of winning."

The alleged reason for combining the references given in the Office Action is "for the purpose of allowing the user to easily generate a plurality of picks for a game, thereby increasing the chances of winning". Applicant respectfully submits that this is not a motivation to make the particular combination discussed in the Office Action at all. In fact the motivation is unrelated to the problems that the Applicant's invention was meant to remedy. As stated in the specification:

> One particular concern associated with such an approach is that it has been determined that a substantial number of gaming slips are submitted with only one of the game panel manual selection regions completed. Thus, the typical gaming slip has a considerable number of unused manual selection regions, which effectively results in waste and added costs for the overall system. On the other hand, it has been determined that many gaming slips are submitted with multiple game panel random request regions filled out to request computer-generated picks. Merely eliminating game panels to reduce the waste associated with unused manual selection regions would therefore result in lost revenue under conventional approaches because the random request regions would also be eliminated. There is therefore a need for an approach that increases the ratio of random to manual play opportunities.

Specification page 1 at [0003]. As indicated, one of the problems that the Applicant's invention was meant to resolve is the reduction of waste of unused manual selection regions while increasing the ratio of random to manual play opportunities. The concerns relating to a manual gaming slip generated by hand as in Jarvis is markedly different than a user performing a quick-pick on a computer-generated pick slip, as in Novak. For example, an ordinary artisan designing a computer-generated pick-slip would not have the same waste

concerns that a substrate game slip design may have. Whereas a substrate game slip may have unused manual selection portions, the game slip displayed on a computer, such as that described in Novak, would not have the same concerns because, as is shown in Novak Fig. 4, there is no wasted space on the final printed game slip. Moreover, using a computer, such as that of Novak, with the system would result in further added costs to the overall system, another concern that the Applicant's invention was addressing. Applicant's invention remedies these problems on a *substrate* gaming slip with "gaming information couple to the substrate" and "a random request region corresponding to a single game wherein the random request region corresponding to the single game enables a plurality of computer-generated picks to be requested for the single game."

Novak does not teach or suggest that a gaming slip that is filled out ***by hand*** should be modified to allow for multiple quick picks in a single random request region, as recited in Applicant's claim one. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. MPEP 2243.01 (citing *In re Ratti*, 270 F.2d 810 (CCPA 1959)). To incorporate Novak's approach to multiple quick picks into Jarvis would require fundamentally altering the manual nature of Jarvis' game entry, to replace it with an automated system like the one used in Novak. Neither Novak nor Jarvis had in mind the concerns of increasing the ratio of random to manual play opportunities while reducing waste associated with unused manual selection regions. Moreover, Novak does not provide the slightest suggestion that this modification should be made, or how this modification should occur in a manual gaming slip like the one in Jarvis.

Finally, in the pick slip shown in Novak's Figure 4, element 64 is not "a random request region" even though it says "Quick Pick". The fields in element 64 are merely present to show a player information about the pick slip, not to enable quick picks to be requested. In Novak, the bar code is what is scanned by the system to determine what sort of ticket a customer with the pick slip wishes to purchase. Novak teaches away from the proposed combinations with Jarvis, because game entries are made with Novak's slip with a ***single***

machine readable bar code, *not* separate random request regions. Novak's use of a single machine readable code, teaches away from any combination with Jarvis, with multiple manual entry areas.

Claims 3-5, 8-10, 24-26, 28, and 37 ultimately depend from claim 1, and thus should be allowable for at least the reasons given above for claim 1.

Independent claim 13 recites "reading a random request region of the gaming slip, the random request region corresponding to a single game; and generating a plurality of picks for the single game, the number of picks based on information read from the random request region." This claim should be allowable for reasons similar to those discussed above for claim 1.

Claims 16 and 40 depend from claim 13, and thus should be allowable for at least the reasons given above for claim 13. Claim 17 should be allowable for reasons similar to claim 13, which has identical recitations in method claim form.

Separately and independently from the arguments given above, Claims 37 and 40 should also be allowable over Jarvis plus Novak because the combination of Jarvis plus Novak does not teach each and every limitation of the claim. Both of these claims recite "the random request region enabling the plurality of computer generated picks to be requested for the single game by marking the marking area with a writing instrument." As was admitted in the Office Action, Jarvis does not teach or suggest the recited random request region, let alone one "enabling the plurality of computer generated picks to be requested for the single game by marking the marking area with a writing instrument." Novak also does not teach or suggest this limitation. Novak's teachings are directed towards a computer system where a player's picks are only performed on the computer lottery device, i.e. by pushing a button. Thus Novak also does not teach or suggest the recited feature. Thus the proposed combination of Novak and Jarvis does not result in a system which has each and every recited feature of claims 37 and 40. For at least this additional reason, claims 37 and 40 should be allowable over Novak and Jarvis.

II.   Rejection of claims 2, 6, 7, 11, 12, 14, 15, 18, 19, 29-33, 35-36, 38 and 39 over Jarvis in view of Novak, and further in view of Alvarez (35 U.S.C. § 103(a))

Claim 2 has similar limitations to claim 1, wherein a "random request region corresponding to the single game enables a plurality of computer-generated picks to be requested for the single game," and thus should be allowable for at least the same reasons given above for claim 1. The addition of Alvarez (5,110,129) does not correct the defect in the cited combination of Jarvis and Novak. Moreover, Applicant also respectfully submits that the proposed combination is improper. Nothing in Alvarez, Jarvis, or Novak teaches or suggests the proposed motivation to combine, that the multi-game card of Alvarez should be applied to Jarvis' game "for the purpose of allowing a user to easily select numbers for different types of games." There is nothing cited that teaches or suggests that an ordinary artisan would be motivated to provide different types of games in Jarvis.

Alvarez generally relates to a pamphlet with removably detached game cards each being used for a particularly lottery drawing. Alvarez, column 2, lines 54-57. When picks are selected on the game card, the must be removed from the pamphlet to be inserted into a standard lottery computer card reading device. *See* Alvarez, column 5, lines 51-58. Thus, Alvarez does not teach "gaming information coupled to the substrate, the gaming information including a plurality of random request regions, each random request region corresponding to a different type of games." Rather in order to use the game cards in Alvarez each game card must be separated from the pamphlet. Thus, Alvarez teaches a plurality of separate substrates wherein each different substrate has a different type of game, as shown in Figures 4-7, rather than a substrate with "gaming information coupled to the substrate, the gaming information including a plurality of random request regions, each random request region corresponding to a different type of game."

Claims 6, 7, 29-33, 35, 36, and 38 depend from claim 2, and therefore should be allowable for at least similar reasons.

Claim 11, recites "a plurality of game panels" each "corresponding to a different game" and each having "a random request region enabling a plurality of computer-generated

picks to be requested for the respectively corresponding game." As discussed above for claim 1, neither Jarvis, nor Novak, nor their combination teach a random request region of this sort. The addition of Alvarez does not correct the defect in the cited combination.

Claims 12 and 39 depend from claim 11, and therefore should be allowable for at least similar reasons.

Claim 14 recites "each random request region corresponding to a different type of game" and generating a number of picks based on information read from the random request region. This claim should be allowable for reasons similar to those discussed above. Claim 15 depends from claim 14 and therefore should be allowable for at least similar reasons. Claim 18 recites identical language with corresponding method claim 14, and should therefore be allowable for similar reasons. Claim 19 depends from claim 18 and should be allowable for at least the same reasons.

Separately and independently from the arguments given above, Claims 38 and 39 should also be allowable over Jarvis plus Novak because the combination of Jarvis plus Novak does not teach each and every limitation of the claim. Both of these claims recite "the random request region enabling the plurality of computer generated picks to be requested for the single game by marking the marking area with a writing instrument." As was admitted in the Office Action, Jarvis does not teach or suggest the recited random request region, let alone one "enabling the plurality of computer generated picks to be requested for the single game by marking the marking area with a writing instrument." Novak also does not teach or suggest this limitation. Novak's teachings are directed towards a computer system where a player's picks are only performed on the computer lottery device, i.e., by pushing a button. Thus Novak also does not teach or suggest the recited feature. Thus the proposed combination of Novak and Jarvis does not result in a system which has each and every recited feature of claims 38 and 39. For at least this additional reason, claims 37 and 40 should be allowable over Novak and Jarvis.

III. Rejection of claims 21-23 and 34 over Jarvis in view of Novak, and further in view of Alvarez and Alexoff (35 U.S.C. § 103(a))

Claims 21-23 and 34 stand rejected under 35 U.S.C. § 103(a), over Jarvis in view of Novak, and in further view of Alvarez and Alexoff (5,979,894). Claim 21 recites in part:

> gaming information coupled to the substrate, the gaming information including a random request region corresponding to a game, wherein the random request region enables a plurality of computer-generated picks to be requested for the game,
> the random request region corresponding to the game comprises a plurality of boxes, and wherein the number of computer-generated picks for the game is indicated by marking one of the plurality of boxes.

Claim 21 should thus be allowable for at least similar reasons as claims 1 and 11 discussed previously. Moreover, claim 21 recites the random request region comprises a plurality of boxes, a feature which the Office Action comments is not found in Jarvis, or Jarvis modified in view of Novak and Alvarez. To correct this admitted deficiency, the Office Action proposes a four-way combination with Alexoff.

As an initial matter, the proposed combination does not yield the claimed invention, because Alexoff does not provide the required feature of a plurality of boxes wherein the number of computer-generated picks for the game is indicated by marking on the plurality of boxes. The Office Action cites the discussion Alexoff 4:11-16 as allegedly describing this missing feature. However, Alexoff 4:11-16 does not discuss Alexoff's playslip – rather it discusses Alexoff's game ticket shown in Alexoff Figure 3. Thus the cited portion of Alexoff is not dealing with any sort of a request region, that enables the request of picks. With respect to Alexoff's playslip, Alexoff does not describe the "number of plays" area shown on the playslip as indicating multiple plays for a particular quickslip box. Rather, it appears that the "number of plays" merely confirms how many columns on the playslip that the prospective player has completed. To obtain multiple quick picks, each separate quick pick box would still need to be checked. *See* Alexoff 4:41-43. The Office Action states, clarifying the previous rejection, that Alexoff discloses an alternative embodiment that can be used to make a plurality of picks for the same day. However, while the picks are in one day or over several days, it still does not change the fact that each "quick pick" box must still be checked off in

order to have a quick pick performed for the specific panel. Thus, Alexoff does not provide the required missing feature of indicating the number of quick picks by marking a box. For at least this reason, claim 21 is not obvious over the proposed combination.

The proposed combination also does not render claim 21 obvious because the Office Action does not provide a proper motivation to combine the references to produce the claimed invention. The Office Action posits that "providing instant gratification to a user" is a motivation to make the proposed four way combination. Applicant respectfully disagrees. An ordinary artisan would not be led to provide boxes indicating a plurality of random picks should be provided to provide "instant gratification" to a user. The proposed motivation to combine or modify does not seem to be fairly interpreted to lead to the proposed combination, let alone Applicant's claimed invention. Moreover, similar to what was discussed previously with respect to Jarvis, Novak, which uses machine-generated entry slips, teaches away from the proposed combination with a manual entry slip of Alexoff. Accordingly, Applicant submits that the proposed combination does not render claim 21 obvious, and respectfully requests withdrawal of the rejection.

Claim 22 and 23 depend from claim 21 and therefore should be allowable for at least the same reasons. Claim 34 depends from claim 2, and therefore should be allowable for at least the same reasons as claim 2. Moreover, claim 34, includes recitations similar to claim 21, and therefore should be allowable for reasons similar to those discussed above for claim 21.

CONCLUSION

In view of the above amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Office is authorized to charge any fees associated with this Amendment to Kenyon & Kenyon LLP Deposit Account No. 11-0600.

Respectfully Submitted,

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